

REMARKS/ARGUMENTS

This Response has not amended or added any claims. Consequently, it is believed that no additional claim fees have been generated by this filing. It is believed, however, that a one-month extension of time is required. A Petition For Extension of Time accompanies this Response. If it is determined, however, that any additional fees are due in this application, the Commissioner is hereby authorized to charge Deposit Account No. 19-2260 in the amount of such fees.

Sections 2 and 3 of the Office Action reject the pending claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-72 of U.S. Patent No. 6,149,062. The Office Action states that the claims are not patentably distinct from each other. Applicants respectfully disagree with the rejection.

Applicants believe that the Examiner has not established a prima facie case of nonstatutory-type double patenting. At least three factors are required to establish such a case. First, the Examiner must identify the inventions claimed in the claims under consideration and in the patent claims. Second, the Examiner must establish that any variation between the inventions claimed in the claims under consideration and the earlier-issued patent claims would have been obvious to a person of ordinary skill in the art. Third, the Examiner's showing of obviousness must follow the analysis used to establish a prima facie of obviousness. The initial burden to establish such a case is on the Examiner. Further, the rejection must include clear evidence to establish why alleged

variations of an invention claimed in a prior patent would have been obvious. A mere finding by an Examiner that the claims themselves are obvious variations is not legally sufficient.

The rejection recites only the features of pending claim 16 and issued claim 1. Although pending claim 16 and issued claim 1 differ in several respects, the only difference identified in the Action is a "size aspect of the data processing assembly in relation to the detachable data reader." The Action concludes by merely stating that this cited difference would be obvious to one of ordinary skill in the art.

Accordingly, the rejection fails to establish a prima facie case. First, the present rejection is based on a dissection of claim language as though it had prior art status. Such a rejection, however, should involve a comparison of the inventions *defined by the claims*, rather than the language in the claims. Second, the rejection does not support its conclusion of obviousness with a citation to valid prior art evidence. In the instant rejection, the obviousness conclusion is based only on the Examiner's view without any evidentiary support. Further, the prior patent (6,149,062) cannot be used as prior art. Further still, the analysis offered with the rejection does not identify and analyze all of the differences between the pending and issued claims. Consequently, it is requested that the double-patenting rejection be withdrawn.


Sections 4 and 5 of the Office Action reject the pending claims under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,347,115 (Sherman et al.). The pending independent claims, however, are disclosed, for example, in the specification of parent U.S. Patent No. 5,227,614. The December 15, 1989, filing date of U.S. Patent No.

5,227,614 is ahead of the earliest referenced date (January 12, 1990) of the cited Sherman et al. patent.

Finally, the Applicants have previously elected the group including claims 16-29 and 37-44 with traverse. This was a provisional election of the type required by 37 CFR 1.143. Applicants have requested reconsideration and subsequent withdrawal of the restriction requirement. Further, a reminder of that traversal was included in the Amendment and Response to Office Action that was filed on March 24, 2004. Applicants hereby repeat their request that the restriction requirement be reconsidered and withdrawn.

Applicants believe that the above remarks provide a complete response to the issues presented in the Office Action. Further, as a result of the demonstrated allowability of the claims, entry of a Notice of Allowance is respectfully requested.

Respectfully Submitted,

By 
Michael F. Williams
Reg. No. 39,875

Simmons, Perrine, Albright & Ellwood, P.L.C.
115 First Street SE, Suite 1200
Cedar Rapids, IA 52401-1266
Telephone: (319) 366-7641 (ext. 222)
Facsimile No. (319) 366-1917